

REMARKS

Applicants have carefully reviewed this application in light of the Office Action mailed May 1, 2006. Claims 13-18 were previously cancelled without prejudice or disclaimer due to an election/restriction requirement, and Claim 5 was previously cancelled without prejudice or disclaimer. Claims 1-4, 6-12 and 19-24 are pending in this Application. Claims 1-4 and 7 stand rejected under 35 U.S.C. § 102(e) and Claims 6, 8-12 and 19-24 stand rejected under 35 U.S.C. § 103(a). Applicants respectfully request reconsideration and favorable action in this case.

Rejections under 35 U.S.C. § 102

Claims 1, 4 and 7 stand rejected in the Office Action under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,592,387 issued to Vernon Komenda et al. (“*Komenda*”).

Claims 1-3 stand rejected in the Office Action under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 5,318,455 issued to Gérard Villiers et al. (“*Villiers*”).

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). Furthermore, “the identical invention must be shown in as complete detail as is contained in the ... claim.” *Richardson v. Suzuki Motor Co. Ltd.*, 868 F.2d 1226, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989). Applicants respectfully submit that neither *Komenda* nor *Villiers* can anticipate Claim 1 because the art cited does not show all the elements of Claim 1.

Independent Claim 1 describes a connector assembly that includes elements that are disposed in specified planes. Notably, the following elements are disposed within a first plane: 1) an assembly housing, 2) a sliding block, and 3) a spring. A connector element is also recited that is disposed in a second plane, where the second plane is offset from and generally parallel to the first plane. In operation, the sliding block “linearly translates the connector between a first position and a second position.”

Examiner cites to *Komenda* as anticipating all of the elements of Independent Claim 1. Specifically, Examiner cites to elements 720 and 726 as teaching an “assembly housing.”

However, as previously argued in Applicants' Response to Final Office Action filed April 21, 2004 (which argument has not been responded to by the Examiner), Applicants note that *Komenda* discloses that element 720 is a "rear plate" and element 726 is a "guide pin block." (Col. 6, lines 19-20). Also, as previously argued (and not responded to by the Examiner), the sliding block 714 cited by the Examiner (the "mounting plate" 714 of *Komenda*) is not "housed" within elements 720 and 726, but is offset or disposed adjacent from these elements. In addition, the spring 722 cited by the Examiner is also not "housed" within elements 720 and 726, but is offset or disposed adjacent from these elements. Accordingly, Applicants submit that *Komenda* fails to disclose, either expressly or inherently, an assembly housing element as recited in Independent Claim 1.

Furthermore, *Komenda* fails to disclose "a sliding block within the assembly housing," where "the assembly housing is located in a first plane [that is] offset and generally parallel to the second plane" in which "the connector is located." The Examiner has included a Figure showing the planes allegedly disclosed in *Komenda* as well as the sliding block 714. Applicants note, however, that the sliding block 714 is not disposed in a plane parallel to the planes identified by the Examiner, but rather extends in a plane that is perpendicular to both planes 1 and 2 identified by the Examiner. Accordingly, Applicants submit that *Komenda* fails to disclose, either expressly or inherently, a sliding block element as recited in Independent Claim 1.

The Examiner also cites to *Villiers* as anticipating all of the claim limitations of Independent Claim 1. However, as previously argued in Applicants' Response to Final Office Action filed April 21, 2004 (which argument has not been responded to by the Examiner), *Villiers* is directed to a connector designed to provide six degrees of freedom to a connector body. (Col. 1, lines 28-29). Independent Claim 1 recites a sliding block that is "operable to linearly translate the connector between a first position and a second position within the second plane." Accordingly, Applicants submit that *Villiers* fails to disclose, either expressly or inherently, the constrained translation of the sliding block claimed by Independent Claim 1.

For at least the reasons set forth above, Applicants respectfully submit that neither of *Komenda* or *Villiers* anticipate Claim 1. Given that Claims 2-4 and 7 depend from Claim 1, Applicants respectfully submit that claims 2-4 and 7 are allowable. As such, Applicants

respectfully request reconsideration, withdrawal of the rejections under 35 U.S.C. § 102(e), and full allowance of Claims 1-4 and 7.

Rejections under 35 U.S.C. § 103

Claims 6, 8-12 and 19-24 stand rejected in the Office Action under 35 U.S.C. § 103(a) as being unpatentable over *Komenda*.

A. The Form of the Examiner's Rejection under 35 U.S.C. § 103(a) is Improper Because the Examiner Failed to Cite *Komenda* with Sufficient Specificity under 35 U.S.C. § 132, 37 C.F.R. § 1.104, and MPEP § 706.02(j) to Allow Applicants to Adequately Respond to the Rejections.

The form of the Examiner's rejection under 35 U.S.C. § 103(a) is improper because the Examiner failed to cite *Komenda* properly and with sufficient specificity under 35 U.S.C. § 132, 37 C.F.R. § 1.104, and MPEP § 706.02(j) to allow Applicants to adequately respond to the rejections. The Examiner's explanation for rejection of Claims 6, 8-12 and 19-24 fails to meet the standards required by U.S. statute. For example, according to 35 U.S.C. § 132, the PTO must notify Applicants of the reasons for rejecting each claim and provide such information and references as may be useful in judging the propriety of continuing the prosecution.

Moreover, the Examiner further defeated the intent and purpose of 35 U.S.C. § 132 by failing to properly identify the portions of *Komenda* that allegedly teach each of the limitations of Claims 6, 8-12 and 19-24. With respect to a number of the claims, the Examiner did not point to any particular portion of *Komenda* as purportedly teaching any particular element of Applicants' claims. Instead, the Examiner merely cited *Komenda* and stated that the claims are obvious in view of it. As an example, although the Examiner rejected Claim 19, the Examiner does not expressly and distinctly set forth specific reasons for the rejection of the method of connecting a computer component to an information handling system recited in Claim 19.

In addition to defeating the intent and purpose of 35 U.S.C. § 132, Applicants respectfully submit that the Examiner's lack of specificity in rejecting the claims does not comply with 37 C.F.R. § 1.104 or MPEP § 706.02(j).

37 C.F.R. § 1.104 states:

In rejecting claims for want of novelty or obviousness, the examiner must cite the best references at his or her command. When a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable. The pertinence of each reference, if not apparent, must be *clearly explained* and each rejected claim specified.

37 C.F.R. § 1.104(c)(2) (emphasis added).

MPEP § 706.02(j) states that after indicating that a rejection is made under 35 U.S.C. § 103:

[T]he examiner should set forth in the Office action:

- (A) the relevant teachings of the prior art relied upon, *preferably with reference to the relevant column of page number(s) and line number(s) where appropriate*,
- (B) the difference or differences in the claim over the applied reference(s),
- (C) the proposed modification of the applied reference(s) necessary to arrive at the claimed subject matter, and
- (D) an explanation why one of ordinary skill in the art at the time of the invention was made would have been motivated to make the proposed modification.

MPEP § 706.02(j) (emphasis added).

Applicants submit that *Komenda* describes an invention other than that claimed by the Applicants, and thus 37 C.F.R. § 1.104 and MPEP § 706.02(j) require the Examiner to designate the particular portions of the cited reference relied on by the Examiner. Since presumably the Examiner read the cited reference when making the determination that the cited reference teaches each and every limitation of Applicants' claims, it should have been reasonably practicable for the Examiner to note which *specific* teachings in the cited reference are purportedly relevant to each element of each of Applicants' claims and why such teachings of the reference are purportedly relevant.

For at least these reasons, Applicants respectfully submit that the Examiner has failed to cite *Komenda* properly and with sufficient specificity to allow Applicants to adequately respond to the rejections under 35 U.S.C. § 103. Thus, the Examiner has clearly failed to comply with 35 U.S.C. § 132, 37 C.F.R. § 1.104, and MPEP § 706.02(j). If the Examiner

maintains rejections of the pending claims based on *Komenda*, Applicants respectfully request that such rejections be sufficiently specific and included in a second Non-Final Office Action, such that Applicants have an opportunity to adequately respond to rejections based on *Komenda*.

B. Claims 6, 8-12 and 19-24 are Not Obvious in Light of *Komenda*.

Assuming, *arguendo*, that the Examiner has set forth adequate reasons for rejection as contemplated by 35 U.S.C. § 132, 37 C.F.R. § 1.104, and MPEP § 706.02(j) (which the Applicants do not concede), rejected Claims 6-12 and 19-24 are not obvious under 35 U.S.C. § 103(a).

In order to establish a *prima facie* case of obviousness, the references cited by the Examiner must disclose all claimed limitations. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974). Furthermore, according to § 2143 of the Manual of Patent Examining Procedure, to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the reference itself or in the knowledge generally available to one of ordinary skill in the art, to modify the reference. Second, there must be a reasonable expectation of success. Finally, the prior art reference must teach or suggest all the claim limitations. The reasonable expectation of success must be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). Applicants respectfully submit that *Komenda* fails to disclose, teach, suggest, or otherwise render obvious Claims 6, 8-12 and 19-24.

With respect to Claims 8-12, Applicants submit that for analogous reasons to those discussed above, *Komenda* fails to disclose all of the elements of Independent Claim 8. For instance, Independent Claim 8 includes similar limitations related to the positioning of the 1) assembly housing, 2) sliding block, and 3) spring elements in a first plane that is "offset from and generally parallel to the second plane" in which "the connector is located." These limitations are not disclosed by *Komenda*.

With respect to Claims 19-24, the Examiner has indicated that these claims have been rejected under 35 U.S.C. § 103(a) as being unpatentable over *Komenda* but, as noted above, has failed to specify how *Komenda* renders obvious these claims. As such, Applicants cannot provide a specific argument/response. However, for the reasons generally discussed above

with respect to the rejections of Independent Claims 1 and 8, Applicants submit that *Komenda* fails to render obvious Claims 19-24.

For at least the reasons set forth above, Applicants respectfully submit that *Komenda* does not render obvious claims 6, 8 and 19. Given that Claim 6 depends from Claim 1, Claims 9-12 depend from Claim 8 and Claims 20-24 depend from Claim 19, Applicants respectfully submit that Claims 6, 9-12 and 20-24 are allowable. As such, Applicants respectfully request reconsideration, withdrawal of the rejections under 35 U.S.C. § 103(a), and full allowance of Claims 6, 8-12 and 19-24.

CONCLUSION

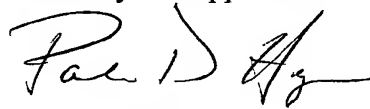
Applicants appreciate the Examiner's careful review of the application. Applicants have now made an earnest effort to place this case in allowance in light of the remarks set forth above. Applicants believe this case is in condition for allowance. For the foregoing reasons, Applicants respectfully request reconsideration of the applications and full allowance of Claims 1-4, 6-12 and 19-24.

Applicants believe no fees are due, however, the Commissioner is hereby authorized to charge any fees or credit any overpayments to Deposit Account No. 02-0383 of Baker Botts L.L.P. in order to effectuate this filing.

If there are any matters concerning this Application that may be cleared up in a telephone conversation, please contact Applicants' attorney at 512.322.2581.

Respectfully submitted,

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A handwritten signature in black ink, appearing to read "Paula D. Heyman", written over the printed name.

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Date: July 31, 2006

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